## REMARKS

In response to the Office Action dated August 28, 2006, the Assignee respectfully requests reconsideration based only on the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited documents to *Inoue*, *Candelore*, *Wong*, *Rowe*, *Patel*, *Hylton*, *D'Luna*, and the Examiner's "Official Notice."

Claims 1-16 are currently pending in this application.

The United States Patent and Trademark Office (the "Office") rejected claims 1 and 12 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Claims 1-4 and 11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,380,984 to Inoue *et al.* in view of U.S. Patent 6,912,513 to Candelore. Claims 12 and 14-15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Inoue* in view of U.S. Patent 6,968,364 to Wong *et al.* and further in view of *Candelore*. Claim 13 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Inoue* in view of *Wong* and *Candelore* and further in view of *Official Notice*. Claims 5 and 8 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Inoue* in view of *Candelore* and further in view of U.S. Patent Application Publication 2005/0060759 to Rowe *et al.* Claims 6 and 7 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Inoue* in view of *Candelore* and *Rowe* and further in view of U.S. Patent Application Publication 2002/0004900 to Patel. Claim 9 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Inoue* in view of *Candelore*, *Rowe*, and *Patel* and further in view of U.S. Patent 5,793,413 to Hylton *et al.* Claim 10 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Inoue* in view of *Candelore* and further in view of U.S. Patent Application Publication 2002/0106018 to D'Luna *et al.*

The Assignee shows, however, that, despite all these cited documents, all the pending claims are neither anticipated nor obviated. Moreover, the scope of the claims is fully enabled by the as-filed application. The Assignee thus respectively submits that the pending claims distinguish over the cited documents, are fully enabled, and are ready for allowance.

**Extension of Time**

Examiner Wilder, please note this response includes a petition for an extension of time in which to respond to an office action. The Assignee respectfully petitions the Commissioner for a two month extension of time from November 28, 2006 to January 28, 2007. The 37 C.F.R. § 1.17 (a) (2) large entity fee of $450 accompanies this petition.

**Telephone Interview**

Examiner Wilder is thanked for the telephone interview of November 8, 2006. Examiner Wilder agreed that the claims were enabled, and Examiner Wilder agreed that the "teaches away" argument (presented herein) was persuasive. Examiner Wilder said he would await formal submission of this response and then conduct another search.

**Rejection under 35 U.S.C. § 112**

The Office rejects claims 1 and 12 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. The test of enablement is whether "undue experimentation" is needed to make or use the invention. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2164.01 (Rev. 1, Feb. 2003) (hereinafter "M.P.E.P."). A specification that teaches an invention in terms which correspond in scope to the terms of the claims must be enabling. *See* M.P.E.P. at § 2164.04.

Claims 1 and 12 are enabling. Examiner Wilder alleges that the claimed feature "*a decoder that decodes the demultiplexed and decrypted transport layer*" is non-enabling. Examiner Wilder, in particular, alleges that "a single decoder decoding the entire transport layer made up of multiple streams does not seem possible." Examiner Wilder, August 28, 2006 Office Action, at page 2. Claims 1 and 12, however, each recite claim terminology that corresponds in scope to the terms used in the as-filed specification. The as-filed application, for example, teaches a decoder that decodes the transport layer:

> In one embodiment of the present invention, **a media server, such as the broadband multimedia gateway (BMG) (Figs. 2 and 6), sends an entire transport layer, rather than a single program stream, over the Network Bus to a digital video broadcast (DVB) device decoder.** The transport layer includes multiple program, data and information streams. For example, the transport layer may include multiple MPEG signals, such as MPEG-2 signals. The media server provides the DVB tuning function with integrated Personal Video Recording (PVR) functionality. **The DVB device decoder of the present invention provides decrypting, demultiplexing, decoding and digital-to-analog conversion. Using this embodiment of the present invention, the complexity of the media server is minimized because it only has to decode a transport layer rather than decoding a single stream of data.**

U.S. Application 10/017,428 at page 24, lines 19-28 (emphasis added). At least this passage shows that the claimed feature "*a decoder that decodes the demultiplexed and decrypted transport layer*" is completely enabled. Examiner Wilder is thus respectfully requested to remove the § 112 rejection.

Examiner Wilder also alleges that some claim 12 features are non-enabling. Examiner Wilder, in particular, alleges that the claimed feature "*a tuner array receiving and demodulating a plurality of transport layers, tuning to a specific transport layer identified by a decoder*" is non-enabling. Examiner Wilder, August 28, 2006 Office Action, at page 3. Claim 12, however, has been amended to clarify that "*another decoder that decodes the demultiplexed and decrypted transport layer.*" Examiner Wilder is thus again respectfully requested to remove the § 112 rejection.

**Traversal of "Official Notice"**

The Assignee traverses the Examiner's "Official Notice." The Office asserts that "thin-client" systems are well known in the computer art. Examiner Wilder, August 28, 2006 Office Action, at page 10, lines 3-7. The Assignee disagrees with these assertions and, respectfully, believes that Examiner Wilder is factually incorrect.

The Assignee, on the contrary, believes that thin-client residential entertainment systems are not well known in the art. The application, and particularly FIG. 3, discusses a "thin-client" digital residential entertainment system. The componentry of this "thin-client" digital residential entertainment system is described at least in part by claims 12 and 13.

The Assignee, then, respectfully, demands that Examiner Wilder provide authority for his assertions. As M.P.E.P. § 2144.04 (C) provides, the Assignee hereby respectfully requests Examiner Wilder to provide documentary evidence to support his assertions.

**Rejection of Claims under 35 U.S.C. § 103 (a)**

All the pending claims were rejected as being obvious over *Inoue* in view of various combinations of *Candelore*, *Wong*, *Rowe*, *Patel*, *Hylton*, *D'Luna*, and the Examiner's "Official Notice." If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

For the following reasons, however, all the *prima facie* cases for obviousness fail.

1. **All the Proposed Combinations Do Not Teach or Suggest All the Features of the Independent Claims, so the § 103 (a) Rejections Fail**

The pending claims are not obvious. All the pending claims recite, or incorporate, features that are not taught or suggested by *Candelore*, *Wong*, *Rowe*, *Patel*, *Hylton*, *D'Luna*, and the Examiner's "Official Notice," whether considered alone or in any combination. Independent claim 1, for example, recites "*a media server tuning to a transport layer and transmitting the entire transport layer, rather than a single program stream, over a system bus*" (emphasis

added). Independent claim 12 also recites "*a tuner array ... sending the entire identified transport layer, rather than a single program stream, over a system bus*" (emphasis added).

All the proposed combinations fail to teach or suggest these features. Examiner Wilder interprets *Inoue's* "digital interface" and its "two lines" between elements 131 ("descramble unit") and 132 (demultiplexer") as a bus, but Examiner Wilder is respectfully mistaken. No where does *Inoue* describe these "two lines" as a bus. *Inoue* merely describes the digital interface 20 as receiving a descrambled transport stream from the descrambler 131. *See* U.S. Patent 6,380,984 to Inoue *et al.* (Apr. 30, 2002) at column 7, lines 62-63. *Inoue*, however, does describe a "bus 31" in the control unit 30. *Id.* at column 6, lines 14-17. If the "two lines" between the digital interface 20 and elements 131 and 132 were a "bus," then *Inoue* would have used similar terminology. The only reasonable interpretation, then, is that the "two lines" between *Inoue's* digital interface 20 and elements 131 and 132 are conventional inputs and outputs. All the proposed combinations, then, fail to teach or suggest "a system bus" as recited by independent claims 1 and 12, so the *prima facie* cases for obviousness must fail. Examiner Wilder is thus respectfully requested to remove § 103 (a) rejections of the pending claims.

**2. *Inoue* "Teaches Away" and Cannot Support the *Prima Facie* Cases for Obviousness**

Any proposed combination of *Inoue* and *Candelore* "teaches away" from the pending claims. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. *See* M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. *See id.* at § 2141.02. "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* M.P.E.P. at § 2143.01.

The Examiner's *prima facie* cases all require impermissible changes to *Inoue's* principle of operation. Examiner Wilder interprets *Inoue's* "digital interface 20" as the claimed

"*broadband input/output module.*" Examiner Wilder also interprets *Inoue's* "external input/output terminal 20T" as the claimed "*network bus.*" Examiner Wilder then attempts to combine *Candelore* with *Inoue* to allegedly obviate "*a network input/output module receiving the transport layer from the network bus.*" Yet this proposed combination requires an impermissible change to *Inoue's* principle of operation. As *Inoue* shows and explains, the external input/output terminal 20T only serves as an input/output interface for the digital interface. *See* U.S. Patent 6,380,984 to Inoue *et al.* (Apr. 30, 2002) at column 9, line 59 through column 10, line 3; *see also* FIG. 1. So, because Examiner Wilder interprets *Inoue's* "digital interface 20" as the claimed "*broadband input/output module,*" *Inoue's* external input/output terminal 20T must then be changed to permit "*a network input/output module receiving the transport layer from the network bus.*" The patent laws, however, forbid changing a principle of operation to support a *prima facie* case. Any proposed combination of *Inoue* with *Candelore*, then, must impermissibly change *Inoue's* principle of operation.

### 3. Because No "Teaching, Suggestion, or Motivation" was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness must include "some teaching, suggestion, or motivation" to combine prior art that is found "either in the references themselves or in the knowledge generally available to one of ordinary skill." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Here the Examiner's *prima facie* case fails to include any teaching, suggestion, or motivation. The Examiner fails to cite any passage from the cited documents. The Examiner cites no passage from the cited documents to support the *prima facie* burden. The Examiner also fails to assert anything found in the knowledge generally available to one of ordinary skill. The *prima facie* cases for obviousness, then, are at least improper for failing to provide any teaching,

suggestion, or motivation to combine, as M.P.E.P. § 2143 requires. The Assignee thus respectfully asserts that the § 103 (a) rejection of the claims should be removed.

**4. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper**

The Examiner's *prima facie* cases for obviousness are defective for another reason. The Examiner's *prima facie* cases for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* cases wholly fail to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* cases for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of the claims should be removed.

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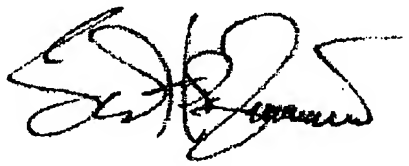
If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or *scott@wzpatents.com*.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390